

TTAB

In the United States District Court
for the Eastern District of Virginia
Alexandria Division

-----X
MILO SHAMMAS,

Plaintiff,

-against-

DAVID KAPPOS, Director of the United States
Patent and Trademark Office,

Defendant.
-----X

Civil Action No. 1:12-CV-1462
(TSE/TCB)

(Serial No. 77/758863)

Hon. Commissioner for Trademarks
Attention: Box TTAB – No Fee
P.O. Box 1451
Alexandria, Virginia 22313-1451

TRADEMARK PROCESS
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U.S. PATENT &
TRADEMARK OFFICE

NOTICE OF COMPLAINT

PLEASE TAKE NOTICE that on December 19, 2012 the above captioned COMPLAINT was filed with the United States District Court for the Eastern District of Virginia, Alexandria Division. 37 CFR § 2.145(c)(4). A courtesy copy of the complaint is attached.

Date: December 19, 2012

By 

John N. Jennison (VSB # 36824)

Kathryn Jennison Shultz (VSB # 21842)

Carl E. Jennison (VSB # 42889)

JENNISON & SHULTZ, P.C.

2001 Jefferson Davis Hwy., Suite 1102

Arlington, Virginia 222023604


(703) 415-1640

(703) 415-0788 (fax)

John@JennisonLaw.com

KJS@JennisonLaw.com

Carl@JennisonLaw.com


12-20-2012

William C. Steffin
Armin Azod
STEFFIN LELKES AZOD LLP
505 North Figueroa Street, Suite 601
Los Angeles, CA 90012
Tel.: (212) 813-5900
williamsteffin@usaiplaw.com
armin.azod@usaiplaw.com

Attorneys for Plaintiff

CIVIL COVER SHEET

Attachment 2

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

MILO SHAMMAS

(b) County of Residence of First Listed Plaintiff Vacaville, CA
(EXCEPT IN U.S. PLAINTIFF CASES)

DEFENDANTS

DAVID KAPPOS,
Director of the United States Patent and Trademark Office

County of Residence of First Listed Defendant Alexandria, VA
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE
LAND INVOLVED.

Attorneys (If Known)

(c) Attorney's (Firm Name, Address, and Telephone Number)
Jennison & Shultz, P.C. 2001 Jefferson Davis Hwy., Suite 1102,
Arlington, VA 22202-3604, (703) 415-1640

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☐ 3 Federal Question (U.S. Government Not a Party)
- ☒ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | | | | | |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| | PTF | DEF | | PTF | DEF |
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER/STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g))	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate Sentence Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act IMMIGRATION <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 463 Habeas Corpus - Alien Detainee <input type="checkbox"/> 465 Other Immigration Actions	FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from another district (specify)
- ☐ 6 Multidistrict Litigation
- ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

15 U.S.C. Sec. 1071(b)

Brief description of cause:

Civil action to overturn denial of trademark registration by United States Patent and Trademark Office

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☐ Yes ☒ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE

12/19/2012

SIGNATURE OF ATTORNEY OF RECORD

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

John N. Jennison
Kathryn Jennison Shultz
Carl E. Jennison
JENNISON & SHULTZ, P.C.
2001 Jefferson Davis Hwy., Suite 1102
Arlington, VA 22202-3604
(703) 415-1640
(703) 415-0788 (fax)
John@JennisonLaw.com
KJS@JennisonLaw.com
Carl@JennisonLaw.com

William C. Steffin
Armin Azod
STEFFIN LELKES AZOD LLP
505 North Figueroa Street, Suite 601
Los Angeles, CA 90012
(213) 507-9796
william.steffin@usaiplaw.com
armin.azod@usaiplaw.com

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
MILO SHAMMAS

Plaintiff,

-against-

DAVID KAPPOS, Director of the United States
Patent and Trademark Office

Defendant.

Case No. 1:12cv 1462

COMPLAINT

TSE/TCB

Plaintiff Milo Shammas (“Plaintiff”), by his undersigned attorneys, Steffin Lelkes Azod, LLP, for his Complaint against defendant David Kappos, the Director of the U.S. Patent and Trademark Office (“Defendant”), alleges as follows:

PARTIES, JURISDICTION AND VENUE

1. Plaintiff, Milo Shammas, is an individual residing in the state of California, with offices at 896 Granada Lane, Vacaville, California, 95688.
2. Defendant David Kappos is the Director of the U.S. Patent and Trademark Office with an address at P.O. Box 1450, Alexandria, Virginia 22313-1450.
3. This Court has jurisdiction over the subject matter of this action pursuant to Section 21(b) of the U.S. Trademark Act of 1946 (the “Lanham Act”), as amended, 15 U.S.C. Sec. 1071(b), which provides that a party dissatisfied with a final decision of the Trademark Trial and Appeal Board (“TTAB”) may institute a new civil action in a Federal District Court challenging such decision. This Court also has subject matter jurisdiction pursuant to 28 U.S.C. Sec. 1331.
4. Venue is proper in this district pursuant to 28 U.S.C. Sec. 1391(e) (1) (A).

FACTUAL BACKGROUND

5. On June 12, 2009, Plaintiff, pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. Sec. 1051(b), filed a federal trademark application based on use, for the mark PROBIOTIC (“Mark”) in standard characters for Ammonium chloride

fertilizer; Ammonium nitrate fertilizer; Ammonium sulphate fertilizer; Blood powder; Bone meal; Brewers' grain; Calcined potassium fertilizer; Calcium silicate fertilizer; Calcium superphosphate fertilizer; Chemical fertilizers; Chemically converted compound fertilizers; Compost; Double or triple superphosphate fertilizer; Fertilizers; Fertilizers and manures; Fertilizers for agricultural use; Fertilizers for domestic use; Fertilizing preparations; Leaf mold; Manganese fertilizer; Marine fertilizer; Mixed fertilizers; Natural fertilizers; Non-chemical bio-fertilizers; Omplex fertilizers; Peat; Potassium chloride fertilizer; Potassium sulphate fertilizer; Rice bran; Sodium nitrate fertilizer; Thomas phosphatic fertilizer; Urea fertilizer (the “Goods”) in Class 1 on the Principal Register. The application was assigned Serial No. 77/758863 (the “Application”).

6. An Office Action issued on September 14, 2009, refusing registration on the basis of being merely descriptive for the identified goods pursuant to Section 2(e)(1) of the Lanham Act, 15 U.S.C. Sec. §1052(e)(1). In addition to being merely descriptive, the Office Action refused registration for the applied-for mark on the basis of being generic in connection with the identified goods and, therefore, incapable of functioning as a source-identifier for applicant’s goods pursuant to Section 2(e)(1).

7. On August 30, 2010, Plaintiff filed a response arguing that PROBIOTIC had acquired distinctiveness over the last 10 years.

8. A Final Office Action, dated February 24, 2011, maintained and made final the merely descriptive and generic refusal to register.

9. On June 6, 2011, Plaintiff amended its dates of use to specify July 12, 2000 for both dates of use and submitted a Section 2(f) claim, both supported by a signed verification.

10. On June 12, 2011, Plaintiff filed a Notice of Appeal with the TTAB

11. On October 18, 2011, Plaintiff also filed an appeal brief with the TTAB, pursuant to Section 21(b) of the Lanham Act, 15 U.S.C. Sec. 1071(b), asserting Defendant erred by, *inter alia*, holding the mark generic and descriptive because the commonly understood definition of the word is not associated in any way with soils and fertilizers.

12. On October 25, 2012 the TTAB issued an order affirming the refusal to register and rejected 7 of the 8 Exhibits attached to Plaintiff's appeal brief.

13. In denying the appeal, the TTAB erred in holding that PROBIOTIC is descriptive for the Goods.

14. In denying the appeal, the TTAB also erred in holding that PROBIOTIC is generic for soils and fertilizers.

15. In denying the appeal, the TTAB also erred in holding PROBIOTIC has not gained secondary meaning in the market for soils and fertilizers.

16. In denying the appeal, the TTAB also erred in holding that the mark has not acquired distinctiveness in the marketplace.

17. In denying the appeal, the TTAB also erred in holding that even if the Plaintiff was the first user of the term PROBIOTIC, it is now a generic term for soils and fertilizers.

18. Moreover, the TTAB did not consider or distinguish that the word-goods association made by the Examiner relating to PROBIOTIC is not made by the general population with regard to soils and fertilizers.

19. The TTAB erred in not reversing the refusal of registration of Plaintiff's application and Mark and in refusing to consider all of Plaintiff's submitted evidence.

FIRST CAUSE OF ACTION

20. Plaintiff incorporates by reference the preceding paragraphs as if fully set forth herein.

21. Plaintiff requests a finding that the mark PROBIOTIC is not generic when used in connection with soils and fertilizers and the Goods.

SECOND CAUSE OF ACTION

22. Plaintiff incorporates by reference the preceding paragraphs as if fully set forth herein.

23. Plaintiff requests that the Court hold as a matter of law that the TTAB erred in refusing the registration of the Plaintiff's mark PROBIOTIC on the basis that the Mark is generic for fertilizer and soils and the Goods and that the Mark is not generic for Plaintiff's Goods.

THIRD CAUSE OF ACTION

24. Plaintiff incorporates by reference the preceding paragraphs as if fully set forth herein.

25. Plaintiff requests that the Court hold as a matter of law that the TTAB erred in refusing the registration of the Plaintiff's mark PROBIOTIC on the basis that the mark is descriptive pursuant to section 2(e) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

PRAYER OF RELIEF

WHEREFORE, Plaintiff requests this Court enter judgment:

- (a) Reversing the Decision of the TTAB, dated October 25, 2012, and to order the allowance of Plaintiff's application for registration of the mark PROBIOTIC on the Principle Register for the Goods.
- (b) Declaring that Plaintiff's mark PROBIOTIC is not merely descriptive when used in connection with the Goods.
- (c) Declaring that Plaintiff's mark PROBIOTIC is not generic for soils and fertilizers or for the Goods.
- (d) Requiring Defendant to approve the Application for publication and subsequent registration upon Plaintiff's establishment of a valid base for registration under Lanham Act Section 1(a); and
- (e) Awarding Plaintiff such other relief as this Court may deem proper.

Dated: December 19, 2012

Respectfully submitted,

JENNISON & SHULTZ, P.C.

By: 

John N. Jennison, Esq. (VSB # 36824)

Kathryn Jennison Shultz, Esq. (VSB # 21842)

Carl E. Jennison, Esq. (VSB # 42889)

JENNISON & SHULTZ, P.C.

2001 Jefferson Davis Hwy., Suite 1102

Arlington, Virginia 22202-3604

703-415-1640

703-415-0788 (fax)

John@JennisonLaw.com

KJS@JennisonLaw.com

Carl@JennisonLaw.com

William C. Steffin, Esq.

Armin Azod, Esq.

STEFFIN LELKES AZOD LLP

505 North Figueroa Street, Suite 601

Los Angeles, California 90012

213-507-9796

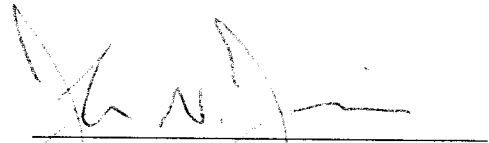
williamsteffin@usaiplaw.com

armin.azod@usaiplaw.com

Attorneys for Plaintiff

CERTIFICATE OF SERVICE


I hereby certify that true and complete copy of the forgoing COMPLAINT was served upon Defendant, to be hand delivered, to Neil H. MacBride, United States Attorney of the Eastern District of Virginia, Justin W. Williams United States Attorney's Building, 2100 Jamieson Avenue,, Alexandria, VA 22314, this 25th day of September, 2012.



John N. Jennison, Esq.

CERTIFICATE OF SERVICE

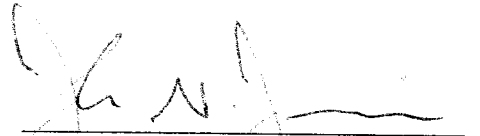
I hereby certify that true and complete copy of the forgoing COMPLAINT was served upon Defendant, to be hand delivered, to Bernard Knight, General Counsel, Office of the General Counsel, United States Patent and Trademark Office, Madison Building East, Room 10B20, 600 Dulany Street, Alexandria, VA 22314, this 19th day of December, 2012.



John N. Jennison, Esq.

CERTIFICATE OF SERVICE

I hereby certify that true and complete copy of the forgoing COMPLAINT was served upon Defendant, by forwarding same via Certified Mail, postage prepaid, to Eric H. Holder, Jr., Attorney General of the United States, U.S. Department of Justice, 950 Pennsylvania Avenue, NW Washington, DC 20530-0001, this 19th day of December, 2012.



John N. Jennison, Esq.